



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,241	02/07/2002	Masahide Sato	219196US0	6563
22850 7590 06/19/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER SISSON, BRADLEY L	
			ART UNIT 1634	PAPER NUMBER
			NOTIFICATION DATE 06/19/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

**Office Action Summary**

Application No.

10/067,241

Applicant(s)

SATO ET AL.

Examiner

/Bradley L. Sisson/

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-7,9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) 5,6,9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Species I, claims 2, 3, 7 and 8, with claims 1 and 4 being generic, in the reply filed on 04 November 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 5, 6, 9, and 10 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 04 November 2004.

### ***Priority***

3. Acknowledgement of claim to foreign priority of Japanese Application, 2001034113, filed 2/9/2001 under 35 U.S.C. 119(a)-(d) has been made, however applicant should note that the translation of this foreign priority document has not yet been received and as a result the claim to foreign priority under the same has not yet been granted.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 1634

5. Claims 1, 2, 4, and 7 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

6. As set forth in *Enzo Biochem Inc., v. Calgene, Inc.* (CAFC, 1999) 52 USPQ2d at 1135, bridging to 1136:

To be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation.' " *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365, 42 USPQ2d 1001, 1004 (Fed. Cir. 1997) (quoting *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)). Whether claims are sufficiently enabled by a disclosure in a specification is determined as of the date that the patent application was first filed, see *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986).... We have held that a patent specification complies with the statute even if a "reasonable" amount of routine experimentation is required in order to practice a claimed invention, but that such experimentation must not be "undue." See, e.g., *Wands*, 858 F.2d at 736-37, 8 USPQ2d at 1404 ("Enablement is not precluded by the necessity for some experimentation . . . However, experimentation needed to practice the invention must not be undue experimentation. The key word is 'undue,' not 'experimentation.' ") (footnotes, citations, and internal quotation marks omitted). In *In re Wands*, we set forth a number of factors which a court may consider in determining whether a disclosure would require undue experimentation. These factors were set forth as follows: (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. *Id.* at 737, 8 USPQ2d at 1404. We have also noted that all of the factors need not be reviewed when determining whether a disclosure is enabling. See *Amgen, Inc. v. Chugai Pharm. Co., Ltd.*, 927 F.2d 1200, 1213, 18 USPQ2d 1016, 1027 (Fed. Cir. 1991) (noting that the *Wands* factors "are illustrative, not mandatory. What is relevant depends on the facts.").

#### The quantity of experimentation necessary

The quantity of experimentation necessary for full enablement of the claims is great- on the order of several man-years, and then with little if any reasonable expectation of success.

The amount of direction or guidance presented.

The amount of guidance provided is extremely limited.

The presence or absence of working examples

The specification has been found to provide the following examples:

Comparative Example 1, "Differentiation of bottom-fermenting yeast based on Lg-FLO1 gene," pp. 18-20;

Example 1, "Obtaining novel fused gene containing a portion of Lg-FLO1 gene N-terminal end, and partial determination of base sequence," pp. 21-26;

Example 2, "Utilizing Lg-FLO1 analogue gene to differentiate bottom-fermenting yeast," pp. 26-27; and

Example 3, Base Sequence of Common Portion of Lg-FLO1 and the Analogue Gene used to differentiate between bottom-fermenting yeasts and wild yeasts, page 27

Of the four examples, only Example 3 relates directly to the claimed method. It is noted with particularity that Example 3 consists of but three sentences, and does not set forth any reaction conditions or starting materials. The situation at hand is analogous to that in *Genentech v. Novo Nordisk A/S* 42 USPQ2d 1001. As set forth in the decision of the Court:

“ '[T]o be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation.' *In re Wright* 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); *see also Amgen Inc. v. Chugai Pharms. Co.*, 927 F. 2d 1200, 1212, 18 USPQ2d 1016, 1026 (Fed Cir. 1991); *In re Fisher*, 427 F. 2d 833, 166 USPQ 18, 24 (CCPA 1970) ('[T]he scope of the claims must bear a reasonable

Art Unit: 1634

correlation to the scope of enablement provided by the specification to persons of ordinary skill in the art.’).

\*\*\*\*\*

“Patent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable. *See Brenner v. Manson*, 383 U.S. 519, 536, 148 USPQ 689, 696 (1966) (stating, in context of the utility requirement, that ‘a patent is not a hunting license. It is not a reward for the search, but compensation for its successful conclusion.’) Tossing out the mere germ of an idea does not constitute enabling disclosure. While every aspect of a generic claim certainly need not have been carried out by an inventor, or exemplified in the specification, reasonable detail must be provided in order to enable members of the public to understand and carry out the invention.

“It is true . . . that a specification need not disclose what is well known in the art. *See, e.g., Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385, 231 USPQ 81, 94 (Fed. Cir. 1986). However, that general, oft-repeated statement is merely a rule of supplementation, not a substitute for a basic enabling disclosure. It means that the omission of minor details does not cause a specification to fail to meet the enablement requirement. However, when there is no disclosure of any specific starting material or any of the conditions under which a process can be carried out, undue experimentation is required; there is a failure to meet the enablement requirement that cannot be rectified by asserting that all the disclosure related to the process is within the skill of the art. It is the specification, not the knowledge of one skilled in the art, that must supply the novel aspects of an invention in order to constitute adequate enablement. This specification provides only a starting point, a direction for further research. (Emphasis added)

#### The nature of the invention

The invention relates to isolation of nucleic acids from crude samples, the conducting of nucleic acid amplification reactions, and the analysis of the amplicons so produced whereby a determination is made as to the identity of multiple organisms.

#### The state of the prior art / The predictability or unpredictability of the art

Art Unit: 1634

Prior, as well as post-filing art teaches of numerous problems confronting those of ordinary skill in the art. These problems have not been addressed by the instant disclosure. Absent specific guidance as to how these issues are to be overcome, one of ordinary skill in the art would be forced to trial-and-error experimentation in an effort to overcome these known issues.

Zhang et al., *Bioinformatics*, Vol. 19, No. 1, 2003, page 14, states:

It is widely recognized that the hybridization process is prone to errors and that the future of DNA sequencing by hybridization is predicated on the ability to successfully cope with such errors. However, the occurrence of hybridization errors results in the computational difficulty of the reconstruction of DNA sequencing by hybridization. The reconstruction problem of DNA sequencing by hybridization with errors is a strongly NP-hard problem. So far the problem has not been solved well.

Chan (US Patent Application Publication US 2002/0119455 A1):

[0018] In practice, Probe Up methods have been used to generate sequences of about 100 base pairs. Imperfect hybridization has led to difficulties in generating adequate sequence. Error in hybridization is amplified many times. A 1% error rate reduces the maximum length that can be sequenced by at least 10%. Thus if 1% of 65,536 oligonucleotides gave false positive hybridization signals when hybridizing to a 200-mer DNA target, 75% of the scored "hybridizations" would be false (Bains, 1997). Sequence determination would be impossible in such an instance. The conclusion is that hybridization must be extremely effective in order to generate reasonable data. Furthermore, sequencing by hybridization also encounters problems when there are repeats in sequences that are one base less than the length of the probe. When such sequences are present, multiple possible sequences are compatible with the hybridization data. (Emphasis added.)

As set forth in Carrico, (US Patent 5,200,313) the extent and specificity of hybridization is affected by the following principal conditions:

- The purity of the nucleic acid preparation.

Art Unit: 1634

- Base compositions of the probe - G-C base pairs will exhibit greater thermal stability than A-T or A-U base pairs. Thus, hybridizations involving higher G-C content will be stable at higher temperatures.
- Length of homologous base sequences- any short sequence of bases (e.g., less than 6 bases), has a high degree of probability of being present in many nucleic acids. Thus, little or no specificity can be attained in hybridizations involving such short sequences. From a practical standpoint, a homologous probe sequence will often be between 300 and 1000 nucleotides.
- Ionic strength- the rate of reannealing increases as the ionic strength of the incubation solution increases. Thermal stability of hybrids also increases.
- Incubation temperature- Optimal reannealing occurs at a temperature about 25 - 30 °C below the melting temperature for a given duplex. Incubation at temperatures significantly below the optimum allows less related base sequences to hybridize.
- Nucleic acid concentration and incubation time- Normally, to drive the reaction towards hybridization, one of the hybridizable sample nucleic acid or probe nucleic acid will be present in excess, usually 100 fold excess or greater.
- Denaturing reagents- the presence of hydrogen bond-disrupting agents, such as formaldehyde and urea, increases the stringency of hybridization.
- Incubation- the longer the incubation time, the more complete will be the hybridization.
- Volume exclusion agents- the presence of these agents, as exemplified by dextran and dextran sulfate, are thought to increase the effective concentrations of the hybridizing elements thereby increasing the rate of resulting hybridizations.



Art Unit: 1634

- Further, subjecting the resultant hybridization product to repeated washes or rinses in heated solutions will remove non-hybridized probe. The use of solutions of decreasing ionic strength, and increasing temperature, e.g., 0.1X SSC for 30 minutes at 65 °C, will, with increasing effectiveness, remove non-fully complementary hybridization products.

Barany et al. (US 2007/0042419 A1), at paragraph 0036 teaches in part:

For allele-specific oligonucleotide hybridization ("ASO"), the mutation must be known, hybridization and washing conditions must be known, cross-reactivity is difficult to prevent, closely-clustered sites due to interference of overlapping primers cannot undergo multiplex detection, and mutant DNA cannot be detected in less than 5% of background of normal DNA.

Choi et al. (US 2007/0042400 A1), at paragraph 0035, teach:

[0035] In conventional methods of preparing nucleic acid, polysaccharides such as starch often co-precipitate with nucleic acid. When polysaccharides co-precipitate with nucleic acid, it is difficult to manipulate nucleic acids by amplification methods, such as PCR, or by other detection methods, such as hybridization detection. Polysaccharides may also inhibit digestion with restriction endonucleases and other enzymatic manipulations.

It is noted that the claimed method fairly encompasses the use of genomic DNA, and the use of an enzyme substrate as a label.

Yasuno et al., (US 2007/0031829 A1), paragraph 0037, teach in part:

Certain oligonucleotides hybridize to polynucleotides having complementary sequences. Although DNA hybridization is sequence-specific, it is difficult to completely exclude hybridizations towards very similar nucleotide sequences.

Wang et al., (US 2007/0009954 A1), teach:

[0004] A number of methods have been developed to score SNPs, including allele-specific hybridization, electrophoretic DNA sequencing, single-nucleotide extension using labeled chain terminators, the "Invader" assay (Third Wave Technologies, Madison Wis.), mass spectrometry, the 5' nuclease assay (Taqman; see below), etc. All of these

Art Unit: 1634

methods entail assays that are either difficult or expensive to develop, or difficult or expensive to perform.

Rowlen et al., (US 2006/0286570 A1) teach:

[0004] A variety of methods exist for detection of molecular recognition events. Detection of molecular recognition events such as DNA hybridization, antibody-antigen interactions, and protein-protein interactions becomes increasingly difficult as the number of recognition events to be detected decreases.

It is noted that the claimed method places no lower limit on the ability to accurately and reproducibly detect any binding between polymer and unit specific markers.

As evidenced above, the art is replete with known issues that directly impact the enablement of the claimed invention. A review of the instant disclosure fails to identify how these art-recognized issues are to be overcome such that the full scope of the invention can be practiced without the public having to resort to undue experimentation.

#### The breadth of the claims

The claims fairly encompass the use of primers that can hybridize at any point on the template, as well as hybridize at multiple points on the template. The method also encompasses the generation of multiple PCR products (amplicons) from different templates that have the same size, yet are to some how be differentiated from one another, thereby allowing for the differentiation of various yeasts. The methods also encompass the use of non-specific primers, or primers that have virtually any number of variations in their nucleotide sequence (see claim 3), and as such one would have absolutely no confidence that the amplicon generated from the use of the primer would correlate with anything.

Art Unit: 1634

7. In view of the breadth of scope claimed, the limited guidance provided, the unpredictable nature of the art to which the claimed invention is directed, and in the absence of convincing evidence to the contrary, the claims are deemed to be non-enabled by the disclosure.

Response to argument

8. At page 7 of the response argument is presented that the citations are not relevant, citing unsubstantiated statistics, and asserting that the primer used is a 20-mer.

9. The above arguments have not been found persuasive, as the method is not limited to any set of condition, e.g., only those complexes that form a perfectly complementary duplex structure are allowed to form. Further, the argument, and more importantly, the specification, fails to teach how the inherent error rate of the polymerase is to be overcome, when as here, there is no upper limit to the number of cycles of amplification to be practiced.

10. As noted above in the body of the rejection, the claims have been construed to encompass the use of not only primers that have the complete sequence, but also primers that have partial sequence, and/or have substitutions, deletions, and rearrangements in the nucleotide sequence of said primers.

11. At page 8 of the response, the following argument is presented:

The presently claimed invention clearly recites "a pair of primers" meaning that only two are present.

The above argument has not been found persuasive, as there is nothing that precludes other primers from being present. Indeed, the claimed method fairly encompasses performing multiplex PCR. Clearly, the specification is silent as to what reagents and conditions are to be employed when such an embodiment is to be performed.

Art Unit: 1634

For the above reasons, and in the absence of convincing evidence to the contrary, claims 1, 2, 4, and 7 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 1, 2, 4, and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. Claims 1 and 2 are indefinite with respect to what constitutes “wild yeast.” It is noted that the very types of yeast that are “bottom-fermenters” are also found in nature. Further, a review of the specification finds that applicant is also seeking to discriminate between different strains of *Saccharomyces cerevisiae*.

***Claim Rejections - 35 USC § 102***

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by New England BioLabs 2000l Catalog.

Art Unit: 1634

17. For purposes of examination, claim 7 has been construed as encompassing a primer pair, wherein one primer has the full-length nucleotide sequence of SEQ ID NO.: 7, and the other primer having the complement nucleotide sequence of SEQ ID NO.: 8, but also fragments thereof, and primers that have mutations, substitutions, rearrangements, etc.

18. New England BioLabs teaches commercially available random primers that comprise all possible 6-mers, 9-mers, 12-mers, 24-mers, and 36-mers. Consequently, the very nucleotide sequences of SEQ ID Nos.: 7 and 8 are present in each of the various pools of random primers.

19. Such a teaching meets a limitation of claim 7.

### ***Conclusion***

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Bradley L. Sisson/ whose telephone number is (571) 272-0751. The examiner can normally be reached on 6:30 a.m. to 5 p.m., Monday through Thursday.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on (571) 272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1634

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bradley L. Sisson/  
Primary Examiner  
Art Unit 1634

BLS